

REMARKS

This Amendment is filed in response to the Office Action dated December 16, 2005. For the following reasons this application should be allowed and the case passed to issue. No new matter is introduced by this amendment. The amendment to claim 1 is supported throughout the specification and further clarifies the scope of claim 1.

Claims 1-3 are pending in this application. Claims 1-3 have been rejected. Claim 1 has been amended.

Inventor Name Change

The name of the inventor of the instant application, Yukio Fujii, has changed to Yukio Matsubara. A petition under 37 C.F.R. § 1.182 was filed on September 1, 2004, requesting that the inventor's name be changed to Yukio Matsubara. In addition, a Substitute Declaration executed by Yukio Matsubara was also filed September 1, 2004, and a declarations under 37 C.F.R. § 1.132 was filed by the inventor. However, the inventor is still incorrectly listed as Yukio Fujii by the United States Patent and Trademark Office (USPTO). Applicants again respectfully request that the USPTO grant the petition under 37 C.F.R. § 1.182 and change inventor Yukio Fujii to Yukio Matsubara in this application.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-3 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Kitano et al. (U.S. Patent No. 6,740,175). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the instant invention as claimed and the cited prior art.

An aspect of the invention, per claim 1, is a rolling bearing ring of a constant velocity joint, employing steel of a component composition consisting of, as alloying elements, at least

0.5 mass % and 0.7 mass % at most of carbon, at least 0.5 mass % and 1.0 mass % at most of silicon, and at least 0.5 mass % and 1.0 mass % at most of manganese with a remainder of iron and inevitable impurities. The rolling bearing ring has a structure in which a raceway surface is subjected to induction hardening.

The Examiner asserted that Kitano discloses a rolling bearing ring of a constant velocity joint comprising the claimed steel composition.

Kitano, however, do not disclose the steel composition required by claim 1. The alloy of Kitano includes Cr and S. The use of "consisting of" as a transitional phrase limits the claims to the recited elements and impurities ordinarily associated therewith. MPEP § 2111.03. Cr and S, as disclosed by Kitano are not impurities, but rather are intentionally added, as evidenced by their disclosed desirable properties (column 4, lines 32-51).

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because Kitano does not disclose the steel composition, as required by claim 1, Kitano does not anticipate claim 1.

Applicant further submits that Kitano does not suggest the claimed rolling bearing ring of a constant velocity joint.

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Dependent claims 2 and 3 are allowable for at least the same reasons as independent claim 1 and further distinguish the claimed invention.

In light of the above Amendment and Remarks, this application should be allowed and the case passed to issue. If there are any questions regarding these remarks or the application in general, a telephone call to the undersigned would be appreciated to expedite prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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